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09/887,492	06/22/2001	Luis M. Ortiz	ORTIZ-1001	7719

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EXAMINER
ELAHEE, MD S

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31 and 79-105* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31 and 79-105* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an amendment filed 05/26/04. Claims 1-31 and 79-105 are pending. Claims 32-78 have been withdrawn.

Response to Arguments

2.   Applicant's arguments mailed on 05/26/04 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Objections

3.   The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim number 84 is not shown in the amendment filed on **05/26/04.**

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-4, 30, 31, 79, 80, 82, 83, 85-86, 89-93 and 98-105 are rejected under 35

U.S.C. 102(e) as being anticipated by Eldridge et al. (U.S. Patent No. 6,515,988).

Regarding claim 1, Eldridge teaches selecting document (i.e., data) from a

portable device (PDA) (i.e., wireless device (WD)) for rendering (abstract; fig.5, 7; col.8,

lines 62-67, col.9, lines 1-12, 24-33, 61-67, col.10, lines 1-6).

Eldridge further teaches selecting a printer (i.e., DRD) not assigned to the PDA

and located in a fixed location accessible by a PDA user to render the document

(abstract; col.7, lines 44-54, col.9, lines 35-45, 61-67, col.10, lines 1-6).

Eldridge further teaches providing document to the printer (i.e., DRD) following

specific action parameters (i.e., commands entered) at the PDA (i.e., WD) (fig.5, 7; col.7,

lines 55-62, col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 2, Eldridge teaches that the printer (i.e., DRD) renders document

after a render command is provided to the printer (i.e., DRD) by the PDA user (col.9,

lines 35-45, 61-67, col.10, lines 1-6).

Regarding claims 3, 86 and 93, Eldridge teaches that the render parameter (i.e.,

command) includes a service identifier (i.e., passcode) (col.7, lines 17-25, 55-61).

Regarding claim 4, Eldridge teaches rendering of the document by the printer (i.e.,

DRD) is controlled by the PDA (i.e., WD) (col.7, lines 55-62, col.9, lines 35-45, 61-67,

col.10, lines 1-6).

Regarding claim 30 is rejected for the same reasons as discussed above with

respect to claim 1. Furthermore, Eldridge teaches requesting support from a network

supporting the PDA (i.e., WD) to assist the user in locating at least one printer (i.e., data

rendering device (DRD)) not assigned to the PDA and accessible to the user of the PDA,

the locating executed by the network following at least one of commands by the user (abstract; col.7, lines 44-54, col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 31, Eldridge teaches that the PDA (i.e., WD) renders data to the printer (i.e., DRD) after a render command is provided by the user associated with the WD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 79, Eldridge teaches receiving a request for the WD at a network supporting the WD to locate at least one printer (i.e., DRD) in accordance with a WD user profile associated with the WD (col.7, lines 44-54, col.9, lines 35-45, 61-67, col.10, lines 1-6).

Eldridge further teaches locating at least one printer (i.e., DRD) matching the WD user profile (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Eldridge further teaches identifying at least one printer (i.e., DRD) matching the WD user profile to the WD in response to the request (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 80, Eldridge teaches that the WD user profile consists of WD location information (col.7, lines 44-54).

Regarding claim 82, Eldridge teaches that the WD user profile includes user destination information (col.7, lines 44-54).

Regarding claims 83, 91 and 92, Eldridge teaches that the data is received at the DRD via a communications network following the commands entered by the WD user at the WD, and the step of providing the data to the DRD is initiated at the WD and process through a wireless network supporting the WD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 85, Eldridge teaches that the step of rendering the data at the DRD follows a rendering command received at the DRD by the WD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 89, Eldridge teaches receiving at a workstation (i.e., network server) a request associated with the WD for delivery of the data for rendering at the printer (i.e., DRD) (col.7, lines 44-54, col.9, lines 35-45, 61-67, col.10, lines 1-6).

Eldridge further teaches determining if delivery of data can be approved by at least one of the network and/or DRD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Eldridge further teaches if delivery is approved, the server processes the request including facilitating delivery of the data to the DRD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 90, Eldridge teaches receiving the data from the server at the DRD (col.9, lines 35-45).

Regarding claims 98, 101, 102 and 105, Eldridge teaches that the command enable WD user manipulation of data during rendering of the data at the DRD using the WD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claims 99, 100, 103 and 104, Eldridge teaches that the DRD is at least a copier (i.e., photocopier) (abstract; col.5, lines 29-31).

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 5, 87, 95 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Kaplan (U.S. Patent No.

6,379,059).

Regarding claim 5, Eldridge fails to teach "the data is provided to the DRD

directly from the WD". Kaplan teaches that the data is provided to the DRD directly from

the WD (fig.1, 2; col.2, lines 61-65, col.3, lines 3-8, col.4, lines 43-51). Thus, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Eldridge to allow the data being provided to the DRD directly from the WD as

taught by Kaplan. The motivation for the modification is to have doing so in order to

make a direct data communication between the PDA and the printer.

Regarding claims 87 and 95, Eldridge fails to teach "said rendering of data at said

DRD follows a rendering command received directly at said DRD by a user associated

with said WD". Kaplan teaches that the rendering of data at the DRD follows a rendering

command directly at the DRD by a user associated with the WD (fig.1, 2; col.2, lines 61-

65, col.3, lines 3-8, col.4, lines 43-51). Thus, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to modify Eldridge to allow

the rendering of data at the DRD following a rendering command directly at the DRD by

a user associated with the WD as taught by Kaplan. The motivation for the modification

is to have doing so in order to make a direct communication between the PDA and the

printer.

Regarding claim 96 is rejected for the same reasons as discussed above with

respect to claim 3.

8.   Claims 6-9, 13, 15-20, 22-24, 26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Cromer et al. (U.S. Patent No. 6,493,104).

Regarding claim 6, Eldridge teaches that data is provided to the DRD via a network supporting the DRD, wherein a render command is provided by the WD user to the network in support of the WD and the network in support of the WD facilitates transfer of data to the network supporting the DRD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

However, Eldridge fails to teach "the WD user identifies the DRD to a network supporting the WD". Cromer teaches that the WD user identifies the DRD to a network supporting the WD (fig.3; col.5, lines 50-58). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow the WD user identifying the DRD to a network supporting the WD as taught by Cromer. The motivation for the modification is to have doing so in order to make a direct data communication between the PDA and the printer.

Regarding claim 7, Eldridge teaches that data is rendered by the DRD after the render command is provided by the WD user to the DRD (col.9, lines 35-45, 61-67, col.10, lines 1-6).

Regarding claim 8, Eldridge teaches that the data is retrieved from an electronic repository (i.e., mailbox) assigned to the WD user only after the WD user provides a passcode to the DRD, and wherein the DRD renders the data after the data is delivered to the DRD (col.9, lines 16-34).

Regarding claim 9, Eldridge teaches that the passcode is provided to the DRD by the WD (col.7, lines 44-54).

Regarding claim 13 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Eldridge fails to teach the network providing the WD with location information for at least one DRD not assigned to the WD and located in a fixed location accessible by the WD user to render the data. Cromer teaches sending that the network providing the WD with location information for at least one DRD not assigned to the WD and located in a fixed location accessible by the WD user to render the data (abstract; fig.3; col.5, lines 31-34, 50-58). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow the network providing the WD with location information for at least one DRD not assigned to the WD and located in a fixed location accessible by the WD user to render the data as taught by Cromer. The motivation for the modification is to have doing so in order to make a selection of the printer to print document.

Regarding claim 15 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, it is not clear whether Eldridge teaches entering a DRD locator request to find at least one DRD not assigned to the WD and accessible to the wireless device user. Cromer teaches sending a query signal (i.e., entering a DRD locator request) to find at least one DRD not assigned to the WD and accessible to the wireless device user (abstract; fig.3; col.5, lines 31-34, 50-58). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow entering a DRD locator request to find at least one DRD not assigned to the WD and accessible to the wireless device user as taught by Cromer. The motivation for the

modification is to have doing so in order to make a direct data communication between the PDA and the printer.

Eldridge further fails to teach receiving location information at the WD for the at least one DRD not assigned to the WD and accessible to the wireless device user. Cromer teaches receiving location information at the WD for the at least one DRD not assigned to the WD and accessible to the wireless device user (abstract; fig.3; col.5, lines 31-34, 50-58). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow receiving location information at the WD for the at least one DRD not assigned to the WD and accessible to the wireless device user as taught by Cromer. The motivation for the modification is to have doing so in order to make a selection of a printer.

Regarding claims 16, 17, 28 and 29 are rejected for the same reasons as discussed above with respect to claim 6.

Regarding claims 18-20 are rejected for the same reasons as discussed above with respect to claims 7-9 simultaneously.

Regarding claims 22-24 are rejected for the same reasons as discussed above with respect to claims 2-4 simultaneously.

Regarding claim 26 is rejected for the same reasons as discussed above with respect to claim 1.

9.   Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Challener et al. (U.S. Patent No. 6,591,297).

Regarding claims 10 and 21, Eldridge fails to teach "said passcode is provided at a user interface located within said DRD". Challener teaches that the passcode is provided at an entry pad (i.e., user interface) located within the printer (i.e., DRD) (fig.1; col.3, lines 16-18). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow the passcode being provided at a user interface located within the DRD as taught by Challener. The motivation for the modification is to have doing so in order to store the location information in the memory.

10.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Cromer et al. (U.S. Patent No. 6,493,104) and further in view of Borza (U.S. Patent No. 6,076,167).

Regarding claim 12, Eldridge in view of Cromer fails to teach "said passcode includes at least one biometric". Borza teaches that the passcode includes at least one biometric (col.8, lines 65-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge in view of Cromer to allow passcode including at least one biometric as taught by Borza. The motivation for the modification is to have doing so in order to provide reduce the information transmitted to the server to a subset of the biometric information.

11.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Ronen (U.S. Pub. No. 2002/0156708).

Regarding claim 14, Eldridge fails to teach "said network further provides WD with a passcode for use at said DRD to render the data as part of said commands". Ronen teaches that the network further provides WD with a password (i.e., passcode) for use at the DRD to render the data as part of said commands (page 3, paragraph 0029).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow network further provides WD with a passcode for use at the DRD to render the data as part of said commands as taught by Ronen. The motivation for the modification is to have doing so in order to provide security for retrieval of data.

12.   Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Boyle et al. (International Pub. No. WO 00/77979 A2).

Regarding claim 81, Eldridge fails to teach "said WD user profile includes DRD capability criteria". Boyle teaches that the WD user profile includes DRD capability criteria (page 7, lines 7-10, page 12, lines 8-15). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow the WD user profile including DRD capability criteria as taught by Boyle. The motivation for the modification is to have doing so in order to provide add to the subscriber based on the profile information.

13.   Claims 88 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Magro et al. (U.S. Patent No. 6,457,078).

Regarding claims 88 and 94, Eldridge fails to teach "said rendering command includes decryption coding". Magro teaches that the rendering command includes decryption coding (abstract; col.3, lines 35-49, col.4, lines 16-24, 31-54). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eldridge to allow the rendering command including decryption coding as taught

by Magro. The motivation for the modification is to have doing so in order to decode the control command associated with token.

14.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Cromer et al. (U.S. Patent No. 6,493,104) and further in view of Magro et al. (U.S. Patent No. 6,457,078).

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claim 88.

15.   Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Cromer et al. (U.S. Patent No. 6,493,104) and further in view of Kaplan (U.S. Patent No. 6,379,059).

Regarding claims 25 and 27 are rejected for the same reasons as discussed above with respect to claim 5.

16.   Claim 97 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (U.S. Patent No. 6,515,988) and in view of Kaplan (U.S. Patent No. 6,379,059) and further in view of Magro et al. (U.S. Patent No. 6,457,078).

Regarding claim 97 is rejected for the same reasons as discussed above with respect to claim 88.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. Wolff (U.S. Patent 6,738,841) teach Method and apparatus for

processing document requests at a printer server.

18.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the date of this final action.

19.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Md S Elahee whose telephone number is (703)305-4822.

The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.   Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

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more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

M.E.
MD SHAFIUL ALAM ELAHEE
July 30, 2004